

Photo Finished

By: Jim Astrachan

A lawyer called last week to say he was sued for copyright infringement. He was really indignant that one of his vendors would sue him when all he had done was represent his client to the fullest of his ability.

As the story unfolded I learned that the lawyer had hired a photographer to shoot aerial photos of a construction site in order to provide hard evidence in a suit. The lawyer's client, a contractor, claimed it was entitled to money for work performed to date. The project's owner claimed that portions of the work had not been finished. The aerial photos would be conclusive.

The photographer's contract required the photographer to deliver to the lawyer one print of each image. The contract read, "additional prints, and sizes are available; please call for a quote".

The photos were shot and delivered to the lawyer. So far so good, but I knew what was coming. The lawyer needed thousands of additional prints for

mediation, depositions and trial, but his client did not want to pay the fee for copies, which the client thought excessive. The photographer then offered to reduce his fee, but still the client refused to agree to payment. When the lawyer did not respond to the new quote, the photographer sent him a letter reminding him that the photographer held the copyrights to the photos. The lawyer then made color photocopies of the photos on his color copier.

These color photocopies were used to litigate the construction case. The photographer learned of this and sent the lawyer a formal notice of infringement and then sued.

In the ensuing litigation, both parties filed cross-motions for summary judgement. The photographer asserted a copyright infringement claim following defendants' unauthorized reproduction of the photos. The lawyer, representing himself and his client, did not contest the photographer's ownership of the copyrights at issue or his unauthorized reproduction of the photos. Instead, he asserted no liability because the reproduction of the photos was a "fair use" within the meaning of 17 USC §107.

I know a little bit about the doctrine of fair use. Now codified, it has existed from the birth of copyright law. It is successfully used as a defense to copyright infringement where the actor violates the rights of a copyright owner but there exists the greater public purpose of providing for the progress of

science and useful arts. In other words, a copyright owner does not have an absolute monopoly under copyright law to control use of his photos. A higher public purpose will defeat the copyright infringement claim and this lawyer believed that use in court was exactly such a purpose. I grew skeptical.

The preamble to Section 107 provides that fair use generally includes use by reproduction for purposes such as criticism, comment, news reporting, teaching (including multiple copies for use in class), scholarship or research. These uses are by no means inclusive. The Copyright Act sets out four non-exclusive factors for courts to consider: purpose and character of use; nature of the work; how much was taken; and effect of the use on the potential market for the work.

The lawyer did not contend he reproduced the photograph for any of the enumerated purposes in the preamble to Section 107, and my eye kept flicking to the last of the fair use factors - the effect of the lawyer's use upon the potential market or value of the work.

But I know that the uses mentioned in the preamble were illustrative only and Section 107 calls for a case by case analysis of the four statutory factors.

Purpose and characterization of use, factor one, examines whether the use is commercial or non-profit. The lawyer said his use is non-profit; he serves justice's interests. The photographer will claim otherwise. It's a very close call - perhaps too close to call and factually determinative.

Courts must consider when assessing factor one, whether the use is "transformative"- does the new work merely supercede the original creation or does it add something new, altering the original work with different meaning or expression. Transformative work supports the fair use defense. The color photocopies served the intended purpose of merely superceding the original photos. There was no added value, no creative metamorphosis. Into the copy machine went the photos; out came exact copies.

Finally, as relates to factor one, the use appears commercial, not withstanding the court's salutary truth-seeking function. This conclusion follows a decision of the United States Supreme Court that "[t]he net of the profit/non-profit distinction is not whether the sole motive of use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price". The lawyer and photographer made a contract governing payment for additional copies. The lawyer paid far less and the photographer got nothing. Strike one against the lawyer.

Factor two examines the nature of the work - is it creative or functional. Although photos serve a function, their nature is more creative than functional, although there are recognized exceptions for photos that are exact copies of art. Here, the photographer made lighting, angle and framing issues. Strike two.

Factor three is the amount of the work taken. It would be hard for the lawyer to argue he had not taken one hundred percent of every photo he ordered reproduced. Strike three.

If any confusion exists whether the lawyer swung and missed on factors one through three, factor four, effect on the market, clearly benched the lawyer. This is the single most important factor a court must consider. Litigation is the only reason the photos were ordered, and was the principal market therefor. By making his own copies, the lawyer obliterated the photographer's only market for these works. His exact duplication, then, became a market replacement.

"So, what do you think of my chances", queried the lawyer? "Settle", I replied.

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